IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Kenneth Rundt and Matti Korpela
Patent No.	:	7,622,046 B2
Issued	:	November 24, 2009
Application No.	:	10/531,464
Filed	:	October 13, 2005
For	:	MAGNETIC TRANSFER METHOD, A DEVICE FOR TRANSFERRING MICROPARTICLES AND A REACTOR UNIT

Examiner	:	David A. Reifsynder
Art Unit	:	1797
Docket No.	:	150026.470USPC
Date	:	December 16, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT

Commissioner for Patents:

Applicants hereby request reconsideration of the patent term under 35 U.S.C. 154(b) of the above-identified patent. Applicants believe this Applicant for Patent Term Adjustment is timely (2 months from issuance) and includes a fee of $200.

Statement of the Facts:

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 512 to 955 days, is respectfully requested.

(I) Measuring Overlap of "A Delay" and "B Delay"

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays"

are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § I 54(b)(2)(A). As outlined in *Wyeth et al. v. Jon W. Dudas* (U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30,2008), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. *Id.*

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The *Wyeth v. Dudas* court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years." "B delay" begins only after the PTO has failed to issue a patent within three years, not before. *Id.*

(2) Measuring "B Delay" for a National Stage Filing under 35 U.S.C. § 371

In addition to and independent of the "overlap" issue addressed above, Patentee respectfully submits that the Office did not apply the proper standard for determining the period of "B Delay" under 35 U.S.C. § 154(b)(1)(B). It is Patentee's understanding that for purposes of calculating "B Delay," the Office measured application pendency as beginning on October 13, 2005, the date on which the application fulfilled the requirements of 35 U.S.C. § 371. However, as detailed below, the relevant statutes and regulations require that when calculating "B Delay" for a national stage filing under 35 U.S.C. § 371, application pendency must be measured from the date that is 30 months from the priority date of the international application (i.e., not from the date on which the application fulfilled the requirements of 35 U.S.C. § 371).

The term of a patent shall, under certain circumstances, be extended if the Office fails to issue a patent within three years after the "actual filing date" of the application.

> (B) GUARANTEE OF NO MORE THAN 3- YEAR APPLICATION PENDENCY.- Subject to the limitations under paragraph (2), if the issue

> of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States ... the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. 35 U.S.C. § 154(b)(1)(B). (emphasis added)

37 C.F .R. § 1. 702(b) explains the meaning of the term "actual filing date" as used in 35 U.S.C. § 154(b)(1)(B). As detailed below, PTO delay for a national stage application begins if the Office fails to issue a patent within three years after the date the national stage "commenced under 35 U.S.C. 371(b) or (f).[1]"

> (b) *Failure to issue a patent within three years of the actual filing date of the application.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U,S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including ... 37 C.F.R. § 1.702(b). (emphasis added)

35 U.S ,C. §§ 371(b) and (f) refer to the time when a national stage application "commences."

> (b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty, 35 U.S.C. § 371(b). (emphasis added)
>
> (f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with, 35 U.S.C. § 371 (f).

[1] Consistent with 37 C,F,R, § 1.702(b), MPEP § 2730 states that "[i]n the case of an international application, the phrase 'actual filing date of the application in the United States' [as used in 35 U,S,C, § 154(b)(1)(B)] means the date the national stage commenced under 35 U,S,C. 37l(b) or (f)."

35 U.S.C. § 371(f) relates to the situation where an applicant files an express request for early processing of an international application. In the absence of filing such a request, the U.S. national stage commences under the provisions of 35 U.S.C. § 371(b), i.e., with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. The term "the treaty" refers to "the Patent Cooperation Treaty done at Washington, on June 19,1970." See 35 U.S.C. § 351(a).

The articles of the Patent Cooperation Treaty cited in 35 U.S.C. § 371(b) are reproduced below.

Article 22

Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 30 months from the priority date. (emphasis added)

(2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).

Article 39

Copy, Translation, and Fee, to Elected Offices

(I) (a) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under

> Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date. (emphasis added)

"The applicable time limit" referred to in Patent Cooperation Treaty articles 22(1), 22(2), and 39(1)(a) is the time at which Applicant files a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pays the national fee (if any), to each designated Office, but "not later than the expiration of 30 months from the priority date." As a result, the time at which Applicant files a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pays the national fee (if any), to each designated Office, but "not later than the expiration of 30 months from the priority date" is the time at which the U.S. national stage commences under the provisions of35 U.S.C. § 371(b). This same conclusion as to the timing for commencement of the U.S. national stage is also summarized in MPEP § 1893.01.

> Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c). MPEP § 1893.01. (emphasis added)

In view of the foregoing, the "actual filing date" of a U.S. national stage application filed under 35 U,S.C. § 371, for purposes of calculating "B Delay" under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b), is the date that is 30 months from the priority date of the international application or the date that the Applicant files a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pays the national fee (if any), to each designated Office,

but "not later than the expiration of 30 months from the priority date."[2]

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

"A Delay"

A first PTO action was due on or before December 13, 2006 (the date that is fourteen months after October 13, 2005, the date on which the application fulfilled the requirements of 35 U.S.C. § 371). The PTO mailed the first non-final Office Action on June 26, 2008, thereby accruing a PTO Delay of 561 days. In addition, on December 29, 2009, Petitioners' filed a response to a non-final Office Action. A PTO reply to this response was due April 29, 2009, i.e., not later than four months after the date on which the reply was filed. The PTO mailed a Notice of Allowance, July 10, 2009, thereby accruing an additional PTO delay of 72 days. Thus, PTO calculates a total "A Delay" of 633 days.

Patentee does not dispute the PTO's calculation for this "A Delay" that includes the time from December 14, 2006 (the day after the date that is fourteen months after the date on which the application fulfilled the requirements on 35 U.S.C. § 371), to June 26, 2008; and in addition, the time from April 30, 2009, to July 10, 2009 (the day after the date that is four months after the date a reply under § 1.111 was filed to the date of mailing a notice of allowance under 35 U.S.C. § 151). See 37 C.F.R. §§ 1.702(a)(1), 1.702(a)(2), 1.703(a)(1), and 1.703(a)(2).

In view of the period of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 633 days.

"B Delay"

The present application is a national stage filing under 35 U.S.C. § 371 of international application number PCT/IB2003/004646, filed October 20, 2003, which claims the benefit of priority of Finnish application number 20021870, filed October 18, 2002.

The national stage for the present application "commenced" under the provisions

[2] In contrast to reliance on "the expiration of 30 months from the priority date" for measuring "B Delay," the beginning of the relevant period for purposes of calculating "A Delay" is the date on which an international application fulfills the requirements of35 U.S.C. § 371. See 35 U.S.C. § 154(b)(l)(A)(i)(II)and 37 C.F.R. § 1.702(a)(1)

of 35 U.S.C. § 371(b), i.e., the date that the Applicant filed a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and paid the national fee (if any), to each designated Office. As a result, the date that the national stage commenced was April 15, 2005 (i.e., the date that the Applicant filed a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and paid the national fee (if any), to each designated Office, but not later than the expiration of 30 months from the priority date, which is April 18, 2005).

The period beginning on April 16, 2008 (the day after the date that is three years after April 15, 2005, the date that the national stage commenced), and ending November 24, 2009 (the date the patent was issued), is 588 days in length.

In view of the period of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 588 days. The PTO calculated 121 days of delay for issuance of a patent more than three years after filing. The PTO has calculated a "B Delay" for this patent of 72 days. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 588 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

December 14, 2006 to June 26, 2008;

April 30, 2009 to July 10, 2009.

As detailed above, "B Delay" accumulated during the following period:

April 16, 2008 to November 24, 2009.

The "A Delay" and the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 145 days, from April 16, 2008, to June 26, 2008 and from April 30, 2009 to July 10, 2009.

Applicant Delay

The total amount of time attributed to Applicant delay is 121 days.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 512 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

1) Total PTO Delay should be calculated as 955 days (i.e., the sum of 633 days of "A Delay" and 588 days of "B Delay" minus the 145 days of overlap minus 121 of total applicant delay). The PTA calculations and relevant dates are graphically represented in Exhibit A.

Total PTA should be calculated as 955 days.

The Director is authorized to charge any additional fees due by way of this Application, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

/William T. Christiansen/
William T. Christiansen, Ph.D.
Registration No. 44,614

WTC:jto
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

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